

Appl. No. : **10/574,740**
Filed : **January 22, 2007**

REMARKS

Claims 1-18 and 21-34 are canceled herein without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the canceled claim in this or any other patent application.

New Claims 35-51 are added herein. The amendments are supported by the claims and specification as originally filed. No new matter is added by the amendments to the claims.

Upon entry of the amendments, Claims 35-51 are pending herein.

Applicants respond below to the objections and rejections made by the Examiner in the Office Action of December 1, 2008.

Discussion of Rejection Under 35 U.S.C. § 112, First Paragraph - Enablement

Claims 1, 3-18, and 21-34 have been rejected as allegedly not being described in the specification in such a way as to enable the skilled artisan to make and use the invention commensurate in scope with the claims. The Office Action states that the specification is enabling for a recombinant promoter comprising the promoter sequence of SEQ ID No. 1 and the intron sequence of SEQ ID No. 2, a chimeric gene comprising said recombinant promoter operably linked to a coding sequence of interest, a method of transforming a plant with said chimeric gene, and a transgenic plant and progeny thereof comprising said recombinant promoter or chimeric gene. However, the Office Action states that Applicants have not provided guidance for teaching promoters regions having at least 90% sequence identity to SEQ ID NO: 1 or 2.

Applicants respectfully submit that the full scope of the claims is enabled in light of the teachings of the specification and the knowledge in the art at the time of filing of the instant application. Nevertheless, for the purpose of expediting prosecution, Applicants have herein canceled Claims 1-18 and 21-34 and added new Claims 35-51. The new claims are directed to methods of causing epidermis specific expression of a desired coding sequence in a transgenic plant and methods for increasing pathogen resistance in a plant using chimeric genes comprising promoter regions "comprising a first sequence originating from the promoter of a GSTA1 gene and a second sequence originating from the intron of a WIR1a gene, wherein the first sequence is SEQ ID No. 1 and the second sequence is SEQ ID No. 2 or wherein the first sequence has at least

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95% sequence identity to SEQ ID No. 1 and the second sequence has at least 95% sequence identity to SEQ ID No. 2." Applicants respectfully submit that one of ordinary skill in the art, in view of the knowledge in the art and the teachings in the specification, could have practiced the entire scope of the claimed invention without undue experimentation.

Moreover, Applicants note that the language of the new claims submitted herein corresponds closely to the claim language proposed by the Examiner on April 28, 2009 as being allowable.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the enablement rejection under 35 U.S.C. §112.

Discussion of Rejection Under 35 U.S.C. § 112, First Paragraph – Written Description

Claims 1, 3-18, and 21-34 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states that the specification fails to sufficiently describe the claimed invention that one skilled in the art would recognize that Applicants are in possession of the invention as broadly claimed.

Applicants respectfully submit that the full scope of the claims is adequately described. Nevertheless, for the purpose of expediting prosecution, Applicants have herein canceled Claims 1-18 and 21-34 and added new Claims 35-51 as described above. Applicants respectfully submit that the full scope of the new claims is supported by the instant application, and Applicants also submit that the new claims do not add new matter. In particular, support for the new claims can be found, for example, at pg. 3, fourth full paragraph, to pg. 8, fifth full paragraph, and at pg. 13, third full paragraph, of the specification as originally filed. In view of the teachings of the specification, one of skill in the art would have known that Applicants possessed the full scope of the presently claimed subject matter.

In view of the claim amendments and the Examiner's proposed allowable claim language discussed above regarding the enablement rejection, Applicants respectfully request that the Examiner reconsider and withdraw the written description rejection under 35 U.S.C. §112.

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Conclusion

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art.

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, the Examiner is invited to call the undersigned directly.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

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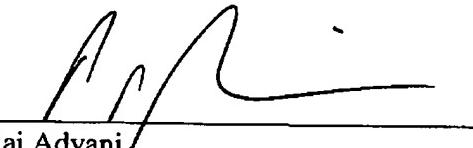
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2009-06-01

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